

purchase. The user's credit card company would pay the seller, and the user would be charged on his monthly credit card bill.

However, under the invention, the user pays the terminal/ATM for the purchase, and **does not pay the seller**. The terminal/ATM then pays the seller, using the terminal's own resources, such as a credit card owned by the terminal.

The identity of the user/purchaser is thus not disclosed to the seller. Nor is a credit card number of the user/purchaser disclosed to the seller.

#### **RESPONSE TO OBVIOUSNESS REJECTIONS**

All claims were rejected on grounds of anticipation, based on Barcelou and Flenley

#### **Barcelou Reference**

Barcelou combines an ATM with a vending machine, in a single kiosk. He intends to cover all types of vending machines imaginable. (See column 3, line 30 et seq.)

Barcelou indicates that, if the user swipes a credit card at the kiosk, the credit card information is transmitted to the merchant. Barcelou gives the example of purchasing gasoline using a credit card. (Column 5, lines 21 - 24.) Plainly, the gas station relays the credit card information to a central office which manages the gas station, or at least which handles payment

for the gas station.

Applicant points out that, in Barcelou's system, the identity of the credit card user is disclosed to the seller. For example, the undersigned attorney frequently purchases lumber and tools from a specific home center, using a credit card. The home center prints a receipt bearing the name of the undersigned attorney. This name is clearly derived from the mag-stripe on the credit card, or from the credit card company based on the account number read from the mag-stripe, a combination of these two sources, or in some other way, based on the credit card.

Thus, in an ordinary credit card transaction, as in Barcelou, the identity of the purchaser is disclosed to the seller.

Under one form of the invention, the identity is not disclosed: the purchaser remains anonymous. (See Specification, page 2, lines 12, 13 and lines 8, 9.)

#### Claim 1

##### Point 1

Claim 1 recites two "payments."

- Claim 1(a) recites means for receiving payment A from the user of the ATM,
- Claim 1(b) recites means for delivering a payment B to a third party (who sells something to the user).

Under the terms of the claim, the ATM comprises both "means" which handle the two payments.

Those two "payments" have not been shown in the applied references. MPEP § 2143.03 states:

To establish prima facie obviousness . . . all the claim limitations must be taught or suggested by the prior art.

Point 2

Regarding the payment B to the third party (who sells something to the user), claim 1(b) states that the payment is made using a credit card assigned to the terminal/ATM.

That has not been shown in the applied references.

Point 3

Claim 1(b) states that the third party does not learn an account number of the user of the ATM. That is directly contrary to Barcelou, who states (column 4, line 27 et seq.) that the user of Barcelou's ATM pays for a purchase using a credit card.

Plainly, the recipient of the payment in Barcelou learns the account number of the credit card. If the recipient did not, then the recipient could not request a charge against the credit card.

Restated: if the recipient in Barcelou did not learn an account number, against which to levy a charge, then how does the recipient get paid ?

Point 4

Barcelou may teach two different things.

On the one hand, he appears to state that the operator of the ATM is also the party who sells items to the user of the combined ATM/vending machine. (Column 4, lines 14 - 26, for example.) In this case, no "third party" is present, as in claim 1.

Further, if no "third party" is present, then the operator of Barcelou's ATM obtains the payment information, such as a credit card number, from the user of the ATM. That is contrary to claim 1.

Therefore, in this situation, Barcelou does not show the required elements of claim 1.

On the other hand, Barcelou states:

FIG. 3b illustrates a combined ATM and  
Internet retail terminal . . .

(Column 4, lines 42, 43.)

This may show a "third party." However, Barcelou discusses no approach to making payment to the third party, apart from the discussion at column 4, line 27 et seq. As explained above, that discussion merely refers to an ordinary credit card transaction, or similar, wherein the user of Barcelou's ATM provides a credit card number to the third-party seller.

Therefore, in this situation, the third-party seller obtains a credit card number, contrary to claim 1.

To repeat: on the one hand, no "third party" is present in Barcelou, as claimed, so claim 1 is not shown for that reason.

On the other hand, if a "third party" **IS PRESENT**, the user in Barcelou deals directly with the "third party." That party obtains a credit card number, contrary to claim 1.

In addition, in the latter situation:

-- There is no "credit card assigned to the terminal" as in claim 1(b)(i).

-- The recitation that the "third party payment . . . does not allow the third party to learn the identity of the user" is not found. (Claim 1(b)(ii).)

#### Conclusion

Several elements of claim 1 are not found in the references, even if combined.

#### **Claim 2**

Claim 2 recites a "browser," such as an Internet browser.

The Office Action admits that Barcelou fails to show the "browser," but cites Flenley as showing the browser.

Point 1

The rationale for adding Flenley's browser to Barcelou is to "provide viewing and selection of various goods and services."

However, Applicant points out that a "browser" is only effective to reach web sites on the Internet. A person can only use the "browser" to make a purchase, if a web site is equipped to sell items over the Internet.

That is, not every web site is equipped to sell items in on-line transactions.

The PTO has not shown that the items which are sold in Barcelou (eg, those listed in column 3, line 30 et seq.) are sold by web sites which are reached through browsers.

Thus, the addition of a browser does not enable purchases to be made at those web sites, so the browser does something else.

The added browser would allow a customer of Barcelou's ATM to make purchases at **additional locations**, namely, web sites.

Consequently, Barcelou is being modified to achieve something foreign to his original purpose. MPEP § 2143.01 prohibits this:

THE PROPOSED MODIFICATION CANNOT RENDER THE  
PRIOR ART UNSATISFACTORY FOR ITS INTENDED  
PURPOSE.

THE PROPOSED MODIFICATION CANNOT CHANGE THE  
PRINCIPLE OF OPERATION OF A REFERENCE.

To repeat: the Office Action admits that Barcelou shows no

browser. Thus, Barcelou's users do not execute on-line transactions using a browser. Adding the browser enables the users to execute on-line transactions with compatible web sites.

That is a modification of Barcelou, which adds a completely different function to Barcelou, which is incompatible with his original system.

Point 2

Even if the "browser" of Flenley is added to Barcelou, elements of parent claim 1 are still not found, as discussed above.

Point 3

Applicant respectfully submits that the rationale for combining Flenley's browser with Barcelou is invalid.

The rationale is that Flenley's browser is used as an "alternative" to Barcelou's touchscreen. (Office Action, page 3, bottom.)

Appellant points out that this modification renders Barcelou inoperative. Barcelou's touchscreen is required to view selections by the user, even if the user operates a browser.

This modification is prohibited by the MPEP section cited in Point 2, above.

Point 4

There is no need to add a browser to Barcelou to enable a user to make purchases.

Barcelou, column 3, line 30 et seq., appears to enumerate every type of good or service available in commerce, and he states that his system sells them.

Thus, everything the user could possibly want is sold by Barcelou already. There is no need to add a browser to make purchases.

Therefore, the PTO must show specific items which can be purchased using a browser, which are not available in Barcelou's unmodified system. Then the PTO must provide a valid teaching for modifying Barcelou, by adding that browser.

Point 5

The rationale for adding Flenley's browser to Barcelou does not, as a matter of logic, lead to the conclusion that the addition should be made. Thus, the rationale is not a valid teaching.

The rationale is that the browser "provide[s] viewing and selection of various goods and services." However, Flenley, **by himself**, provides that "viewing."

Restated, if that type of "viewing" is desired, then one simply follows the teachings of Flenley alone. There is no need to add Flenley to Barcelou to attain that goal.



#### Claim 8

The Office Action has not shown several elements of claim 8 in the applied references.

Claim 8 recites two credit card numbers, used in a single purchase. That has not been shown in the applied references.

Claim 8 states that a **first** credit card number is received from a user. Claim 8 states that payment is made to a merchant selling items via a **second** credit card number. That combined operation has not been shown in the applied references.

Claim 8 states that the merchant does not learn the identity of the **first** credit card number. That is not shown in the applied references. Further, that is contrary to the applied references. Both references state that a purchaser's credit card number is given to the seller. (Barcelou, column 4, line 27 et seq.; Flenley, column 1, line 19 et seq.)

#### Claim 21

Claim 21 recites two credit card numbers. That has not been shown in the applied references.

Claim 21 recites "a credit card account assigned to the ATM." That has not been shown in the applied references.

Claim 21 recites "using a credit card account assigned to the ATM, transmitting payment to the selected merchant." That has not

been shown in the applied references.

#### **Claim 22**

Claim 22 states that the user's account number is not disclosed to the merchant. That is directly contrary to Flenley's Background of the Invention and contrary to Barcelou, column 4, line 27 et seq.

#### **Claim 23**

Claim 23 states "no account number of the user is disclosed to the third party." As in claim 22, above, that is contrary to both Flenley and Barcelou.

#### **Claim 24**

Claim 24 recites two credit card numbers. That has not been shown in the applied references.

#### **Claim 25**

Claim 25 recites "an account of the terminal." That has not been shown in the references.

**Additional Comments on Rationale for  
Combining References**

Flenley is cited as showing a "browser," which is added to Barcelou.

However, Applicant submits that several problems exist in the combination of references.

#### Problem 1

The rationale for combining the references is that Flenley's browser is an "alternative" to Barcelou's touchscreen. However, Applicant points out that this is incorrect, as a matter of fact.

A browser is software. A touchscreen is hardware. One uses a touchscreen to issue commands to a browser.

A browser is not, in fact, an alternative to a touchscreen.

#### Problem 2

The rationale is applying the principle of substitution-of-known-equivalents. MPEP § 2144.06 states:

In order to rely on equivalence as a rationale supporting an obviousness rejection, **the equivalency must be recognized in the prior art**, and cannot be based on . . . the mere fact that the components at issue are functional or mechanical equivalents.

The rejection fails to comply with this MPEP section. Recognition of the equivalence in the prior art has not been shown.

### Problem 3

No expectation of success has been shown in replacing Barcelou's touchscreen with a browser. MPEP § 706.02(j) states:

#### Contents of a 35 U.S.C. 103 Rejection

. . . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . . .

**Second, there must be a reasonable expectation of success.**

. . . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

The PTO has not shown how the browser, when substituted for the touch screen, performs the functions of the touch screen, which include

- displaying images,
- displaying buttons for the user to touch, and
- detecting the touching, and issuing commands in response.

Also, the expectation of success in the prior art has not been shown, as required.

#### Problem 4

As explained above, the combination of references renders Barcelou inoperative. If his touchscreen is removed, then his users cannot interact with his computer. MPEP § 2143.01 prohibits this:

THE PROPOSED MODIFICATION CANNOT RENDER THE  
PRIOR ART UNSATISFACTORY FOR ITS INTENDED  
PURPOSE.

THE PROPOSED MODIFICATION CANNOT CHANGE THE  
PRINCIPLE OF OPERATION OF A REFERENCE.

#### Problem 5

No actual teaching has been given for modifying Barcelou. The Office Action has merely asserted (incorrectly) that one element in Flenley is an "alternative" to an element in Barcelou.

That is merely a statement of a supposed fact. A fact is not a teaching for combining the references.

#### Problem 6

MPEP § 2143.01 states:

FACT THAT REFERENCES CAN BE COMBINED OR  
MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA  
FACIE OBVIOUSNESS

The mere fact that references can be combined  
or modified does not render the resultant  
combination obvious unless the prior art also  
suggests the desirability of the combination.

. . . .

FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

Applicant submits that the essential basis of the PTO's rationale for rejecting the claims is no different than the two types of bases which are **specifically prohibited** by this MPEP section.

Restated, this MPEP section states that an invention is not obvious merely because

- references "can be" combined to attain it,
- or
- the combination is "well within the skill of the art."

The PTO's rationale, in essence, is no different than these two prohibited rationales. In essence, the PTO asserts that the browser is an "alternative" to the touchscreen.

Thus, the PTO tacitly states that

- the browser "can be" substituted for the

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touchscreen, or

-- the substitution is within the skill of  
the art.


Applicant submits that the PTO is, in effect, applying the two  
prohibited rationales discussed above.

#### CONCLUSION

Applicant requests that the rejections to the claims be  
reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful  
consideration given to this case.

Respectfully submitted,

  
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